



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 8

In re Application of :
Mark Rasper : DECISION ON PETITION
Application No. 09/222,282 :
Filed: December 28, 1998 :
For: Knife Indexing Apparatus :

This is a decision on the petition filed on May 25, 2000 requesting that the finality of the Office letter dated May 9, 2000 be withdrawn. The petition is considered pursuant to 37 CFR § 1.181, and no fee is required for the petition. A refund of the \$130.00 petition fee tendered will be scheduled.

The petition is denied.

Petitioner sets forth the facts upon which relief is requested, and a review of the file confirms that the facts are as follows:

1. The instant application was filed on December 28, 1998.
2. As filed, the instant application claims benefit of provisional application 60/070,405.
3. Provisional patent application 60/070,405 was filed on January 5, 1998.
4. In response to a restriction requirement promulgated on December 22, 1999, petitioner filed an election to prosecute claim 1 on January 4, 2000.
5. In an Office letter dated February 10, 2000, claim 1 was rejected under 35 USC 103(a) as being unpatentable over the patent to Bailey in view of the patent to Cavelli.
6. The patent to Bailey issued on June 9, 1998 on an application filed on April 15, 1997.
7. On March 8, 2000, petitioner replied to the Office letter dated February 10, 2000 by traversing the rejection on the grounds that petitioner was entitled to benefit of the provisional application date of January 5, 1998, and that the Bailey patent was therefore unavailable as prior art in a section 103(a) rejection.
8. In the Office letter dated May 9, 2000, the rejection of claim 1 was repeated on the grounds that the claim was unpatentable under 35 USC 103(a) over the patent to Bailey in view of the patent to Cavelli, "as set forth in the previous Office action". This letter was made final.

9. In response to the arguments presented by petitioner regarding the unavailability of the Bailey patent as prior art because of petitioner's entitlement to the filing date of the provisional application, the Office letter dated May 9, 2000 included a reply to the effect that the Bailey patent qualified as prior art under 35 USC 102(e) because the filing date of the Bailey patent was earlier than the filing date of petitioner's provisional patent application. The examiner concluded that for this reason, it was proper to apply the Bailey patent as prior art in an obviousness rejection under 35 USC 103(a).


As discussed below, these facts fail to demonstrate that the examiner committed clear error, or abused his discretion by acting in an arbitrary or capricious manner in making the Office letter dated May 9, 2000 final.

MPEP 706.07(a) *requires* that the second Office action on the merits (patentability of the claims) be made final except where the examiner introduces a new ground of rejection of the claims not necessitated by applicant's amendment of the claims. Here, the original claim was not amended, and the second action on the merits repeated exactly the same rejection of that claim as was set forth in the first action on the merits. Petitioner appears to be confusing the examiner's reply to petitioner's traverse of the first Office action on the grounds that "the Bailey patent is unavailable as a 35 USC 103(a) reference" with a new ground of rejection. The examiner's reply to petitioner's traverse merely pointed out that on the facts of this case, the examiner considered that entitlement to the benefit of the provisional application filing date did not remove the Bailey patent from the status of prior art, because the Bailey patent qualified as prior art under 35 USC 102(e). Because the examiner believed that Bailey patent qualifies as prior art under 35 USC 102(e), the examiner maintained the 35 USC 103(a) initially advanced in the first Office action. Stating this belief did not change the grounds of rejection in the final action, or convert the rejection into a rejection that differed from the rejection made in the first Office action. No anticipation rejection under 35 USC 102(e) was made in the final Office action.

Because the final action contains the same ground of rejection that was made in the first Office action and does not contain any new ground of rejection, it appears that the examiner acted properly in making the second Office action final. The presence of the examiner's reply to petitioner's argument that the provisional application renders the Bailey patent unavailable as a reference does not constitute a new ground of rejection, especially since no new interpretation of the teachings of the Bailey patent are relied upon in the section 103 rejection. Petitioner is not entitled to the relief requested in the petition merely because of the reply by the examiner to petitioner's argument.

Any request for reconsideration of this decision must be filed within two months from the date of the decision, 37 CFR § 1.181(f). Petitioner is reminded that the filing of the petition does not stay the running of the shortened statutory period for filing a reply to the final Office action dated May 9, 2000, and that the filing of a request for reconsideration of this decision will not stay the running of that shortened statutory period.

PETITION DENIED.


E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

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